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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,143	02/14/2007	Michael Butters	06275-514US1 101315-1P US	1966
26164 7590 11/16/2007 FISH & RICHARDSON P.C. P.O BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER MURRAY, JEFFREY H	
			ART UNIT 1624	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,143	Applicant(s) BUTTERS ET AL.	
	Examiner Jeffrey H. Murray	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).¹
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/31/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to an application filed on May 31, 2006. There are ten claims pending and ten claims under consideration. This is the first action on the merits. Clarification is requested on Claim 8. Examiner noticed the additional proviso of "L is a leaving group other than chlorine." Examiner did not locate any prior art where "L is a chlorine group" and would like to know if related prior art exists. The application concerns methods for preparing thiazolopyrimidine compounds, intermediate compounds used in such methods, thiazolopyrimidine compounds so prepared and used in therapy.

Priority

2. Acknowledgment is made of Applicant's claim for foreign priority. This application, U.S. Application No. 10/581,143, filed May 31, 2006, is a national stage application of PCT application PCT/GB04/05072, filed December 2, 2004, and claims foreign priority to British Application No. 0328243.1, filed December 5, 2003.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any of the errors of which applicant may become aware of in the specification.

Claim Rejections - 35 USC § 112, 1st

4. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a compound, composition or pharmaceutically acceptable salt, does not reasonably provide enablement for the solvate. The

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specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

5. The test of enablement is whether one skilled in the art could make and use the claimed invention from the disclosures in the application coupled with information known in the art without undue experimentation. (*United States v. Teletronics Inc.*, 8 USPQ2d 1217 (Fed. Cir. 1988)). Whether undue experimentation is needed is not based on a single factor, but rather a conclusion reached by weighing many factors (See *Ex parte Forman* 230 USPQ 546 (Bd. Pat. App. & Inter. 1986) and *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988)).

These factors include the following:

1) *Amount of guidance provided by Applicant.* Applicant has provided no guidance, examples, or provided data and/or testing results of any solvates in the current application.

2) *Unpredictability in the art.* Predicting the formation of solvates or hydrates of a compound and the number of molecules of water or solvent incorporated into the crystal lattice of a compound is complex and difficult. Each solid compound responds uniquely to the possible formation of solvates or hydrates and hence generalizations cannot be made for a series of related compounds. Certain molecular shapes and features favor the formation of crystals without solvent; these compounds tend to be stabilized by efficient packing of molecules in the crystal lattice, whereas other crystal forms are more stable in the presence of water and/or solvents. There may be too many possibilities so

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that no computer programs are currently available for predicting the crystal structures of hydrates and solvates. (*Advanced Drug Delivery Reviews*; **48**, (2001) 3-26.)

3) *Number of working examples.* Applicant has provided no working examples of a solvate in the present application.

4) *Nature of the invention.* The nature of this invention relates to methods for preparing thiazolopyrimidine compounds, intermediate compounds used in such methods, and thiazolopyrimidine compounds so prepared and used in therapy.

5) *Level of skill in the art.* The artisan using Applicants invention would be a chemist with a Ph.D. degree, and having several years of bench experience.

MPEP §2164.01 (a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here that Applicant is not enabled for making these compounds or compositions.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Willis, et. al., WO 2001025242 and Bonnert, R., WO 2002083693. Claim 1 of Willis, et. al. describes a thiazolopyrimidine compound *or a pharmaceutically salt...thereof* (emphasis added) which may have as R¹ an alkyl group substituted with an optionally substituted aryl group, and an R² and R³ group which may be substituted with an alkyl or hydroxyl-substituted alkyl group. See CAS Registry No. 333742-48-6 in STN search.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Bonnert, et. al., WO 2004026880, describe a thiazolopyrimidine compound *or a pharmaceutically salt...thereof* (emphasis added) which may have as R¹ an alkyl group substituted with an optionally substituted aryl group, and an R² and R³ group which may be substituted with an alkyl or hydroxyl-substituted alkyl group. See CAS Registry Nos. 676345-22-5 (free base) and 676345-23-6 (sodium salt) in STN search.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claim 10 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of Bonnert, et. al., WO 2004026880. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 1 of Bonnert, et. al., WO 2004026880 embraces the instant claim 10.

The instant claim differs from the copending claim by a more limited genus than the claim of the copending application. However, it would have been obvious to one

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having ordinary skill in the art at the time of the invention to select any of the species of the genus of the copending application, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus of the copending application since such compounds would have been suggested by the claims of the copending application. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

9. Claims 1-10 are rejected.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is (571) 272-9023. The examiner can normally be reached on Mon-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a US PTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JHM



James O. Wilson
Supervisory Patent Examiner
Art Unit 1624